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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,207	06/22/2001	Wilfred A. Keller	S&B-C100	5571

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EXAMINER

FOX, DAVID T

ART UNIT PAPER NUMBER

1638

DATE MAILED: 11/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/286,207

Applicant(s)

Keller et al

Examiner

FOX

Group Art Unit

1630

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

- 1 -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 6/22/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

59-99

- ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 59-99 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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In view of the receipt on 28 October 2002 of the signed copy of the unsigned preliminary amendment originally filed 22 June 2001, the specification has been amended, claims 1-58 have been cancelled, and claims 59-74 and 79-103 have been added. The restriction requirement of 3 October 2002 is hereby VACATED in view of the new restriction requirement below.

Claims 79-103 of the preliminary amendment of 22 June 2001 have been renumbered by the Examiner as claims 75-99 per 37 CFR 1.126, since no claims 75-78 were ever submitted. The second preliminary amendment, submitted 24 September 2001, remains unentered, because it improperly attempts to renumber claim 80 the same number as an already submitted (albeit cancelled) claim. The Examiner's renumbering of the claims as indicated above appears to have accomplished most of the intent of the second preliminary amendment. Applicants should submit another amendment requesting cancellation of renumbered claim 75 (formerly claim 79), which is a duplicate of original claim 74.

Claims 59-99 are pending and subject to a restriction requirement as set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 59-76, 83-84, 88-92 and 96-99, drawn to constructs comprising  
Agrobacterium-derived conditionally lethal oncogenes, methods for their use to  
select transform plants and/or remove them from the environment, and the  
resultant plants, classified in class 800, subclass 288, for example.

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- II. Claims 77-79, 85-87, and 93-95, drawn to transformed high oleic acid Brassica plants including a particular cultivar, classified in class 800, subclass 306, for example.
- III. Claims 71 and 80-82, drawn to constructs comprising microbial conditionally lethal genes conferring a non-toxic substance into a toxic one, classified in class 536, subclass 23.7, for example.

Claim 71 will be examined to the extent that it reads on the elected invention.

The inventions are distinct, each from the other because:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects.

The invention of Group I involves Agrobacterium-derived oncogenes, and methods for visual identification of cell proliferation phenotypes, each not required by Groups II and III.

The invention of Group II requires particular Brassica genotypes, including high oleic acid genotypes or a particular cultivar with a particular allele at every locus, each not required by any other group.

The invention of Group III requires non-Agrobacterium-derived conditionally lethal genes which are not oncogenes, which encode products which convert non-toxic substances to toxic

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ones, and further requires methods for identifying lethal phenotypes, each not required by any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November 19, 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180 1638

